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09/560,518	04/28/2000	Richard C. Becker	Re frac-3	3374

7590 02/25/2004  
Donald N Halgren  
35 Central Street  
Manchester, MA 01944

EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/560,518			

EXAMINER	
ART UNIT	PAPER NUMBER
	2/20/04

DATE MAILED:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

1. ☒ The communication filed Nov. 19, 2003 is informal/non-responsive for the reason(s) checked below and should be corrected. APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER OR UNTIL THE EXPIRATION OF THE PERIOD FOR RESPONSE SET IN THE LAST OFFICE ACTION (WHICHEVER IS LONGER) WITHIN WHICH TO CORRECT THE INFORMALITY.

- a. ☐ The amendment to claim(s) \_\_\_\_\_, filed \_\_\_\_\_, fails to comply with the provisions of 37 C.F.R. 1.121 and is accordingly held to be non-responsive. A supplemental paper correcting the informal portions and complying with the rule is required.
- b. ☐ The paper is unsigned. A duplicate paper or ratification, properly signed, is required.
- c. ☐ The paper is signed by \_\_\_\_\_, who is not of record. A ratification or a new power of attorney with a ratification, or a duplicate paper signed by a person of record, is required.
- d. ☐ The communication is presented on paper which will not provide a permanent copy. A permanent copy, or a request that a permanent copy be made by the Office at applicant's expense, is required, see M.P.E.P. 714.07.
- e. ☒ Other fail to comply with 37 CFR 1.111 (see attached comments and MPEP 714.02 & 714.03)

2. ☐ In accordance with applicant's request, THE PERIOD FOR RESPONSE FROM THE OFFICE ACTION DATED \_\_\_\_\_ IS EXTENDED TO RUN \_\_\_\_\_ MONTH(S).

No further extension will be granted unless approved by the Commissioner. 37 C.F.R. 1.136 (b)

3. ☐ Receipt is acknowledged of papers submitted under 35 U.S.C. 119 which papers have been made of record in the file.

4. ☒ Other

attachments

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As discussed in the MPEP (see appendix), in order to be fully responsive all objections & rejections must be replied to, i.e. discussed as to their merits or errors, &/or amended, if they effect the patentability of the claims. See section 4, of paper #12, mailed 5/20/03.

It is noted that matters of 'form', as in the objections to the specification (section 3 & related discussion in section 1) may be held in abeyance as requested (p.1 applicant's 11/19/03 response). However, when considering corrections to the specification, also see p. 10, line 13 "...US Patent # JP10148102A..." which is clearly incorrect. Furthermore, the rules for proper incorporation by reference need to be considered for citations on p. 10, 21 & 22 (the figures are already in the case as figure 1, what else is being incorporated?)

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

To further prosecution, it is further noted that the discussion of "a number of points ...implicitly referred back to the inventor's previous patent...U.S.#5,861,630..." (p.2, 11/19/03 response), fails to cite where in the present specification the patent is cited or referred to. The patent issued about 7 months before the filing of this case's provisional parent application, so is not & cannot be a continuation thereof. No citation was found by the examiner in this case's specification. Support for claim limitations and meanings must have basis in the present application. Using the previous patent to supply definitions or show inherent structures of something in this case is OK, but the connection to this case must be clearly shown to be an effective argument. Also, any feature argued as critical to the invention (method), should be necessitated by the independent claim's language in order to be convincing. For example, note


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applicant's arguments concerning claims 13 +, "that the film is primarily composed of boron cluster ions" (p.2 of response, emphasis added) is NOT necessitated by claimed "...feedstock consists of a doped solid solution...companion element within boron" (emphasis added), as the feedstock requires neither ions nor clusters thereof, nor do the many claimed deposition techniques necessitate that the film produced from the claimed feedstock must have this structure. The YB<sub>66</sub> sputter deposited film of Kataoka et al is "substantially composed of the element boron" as claimed in 1 & 9, and "the initial ratio of boron to companion element is 20 or greater for said coating" as claimed in 1. Note for the ratio in claim 1 to clearly refer to the feedstock, moving "for said coating" to after "selecting" in line 4 might be considered.

Any inquiry concerning this communication should be directed to Marianne L. Padgett at telephone number (571) 272-1425 on M-F from about 8:30 am - 4:30 pm, call (571) 272-1700 for general information (group 1700), & FAX#(703) 872-9306 (all official).

MLP

2/20/04



MARIANNE PADGETT  
PRIMARY EXAMINER

## EXAMINATION OF APPLICATIONS

714.02

the amendment as well, particularly where certified copies for priority purposes are requested.

Preliminary amendments should either accompany the application or be filed after the application has received its application number and filing date. See MPEP § 502.

Any amendment canceling claims in order to reduce the filing fee should be filed with the application. Since only amendments canceling claims are entered before the filing fee is calculated, any other changes to the claims and/or specification should be part of a separate amendment. See MPEP § 506.

If a preliminary amendment fails to comply with 37 CFR 1.121, applicant will be notified by way of a Notice of Non-Compliant Amendment and given a non-extendable period of one month to bring the amendment into compliance with 37 CFR 1.121. If no corrective action is taken by the applicant, examination of the application may commence without entry of the proposed non-compliant preliminary amendment. See MPEP § 714.03.

A preliminary amendment will be entered unless it is disapproved by the Commissioner. A preliminary amendment may be disapproved by the Commissioner if the preliminary amendment unduly interferes with the preparation of an Office action. 37 CFR 1.115(b). See MPEP § 714.03(a).

## 714.02 Must Be Fully Responsive

*37 CFR 1.111. Reply by applicant or patent owner to a non-final Office action.*

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

- (i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and
- (ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

In all cases where reply to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon

is not to be held not fully responsive for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment which does not comply with the provisions of 37 CFR 1.121(b) and (c) may be held not fully responsive if both a clean version and a marked up version showing changes to the respective parts of the specification/claims are not provided. See MPEP § 714.22.

Replies to requirements to restrict are treated under MPEP § 818.

### 714.03 Amendments Not Fully Responsive, Action To Be Taken

37 CFR 1.135. *Abandonment for failure to reply within time period.*

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(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

If an amendment submitted after March 1, 2001, fails to comply with 37 CFR 1.121 (as revised on September 8, 2000), the Office will notify applicant by a Notice of Non-Compliant Amendment, that the amendment fails to comply with the requirements of 37 CFR 1.121 and applicant will be given a period of time in which to comply with the rule. If the amendment that fails to comply with the requirements of the rule is a preliminary amendment, the Legal Instruments Examiner (LIE) will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the preliminary amendment. If the amendment which fails to comply with the requirements of the rule is an amendment after a non-final Office action, the LIE will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply (37 CFR 1.135). Extensions of time are permitted (37 CFR 1.136(a)). Failure to reply to this Notice will result in abandonment of the application. See MPEP § 714.22 for treatment of non-compliant amendments after final rejection.

Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable). This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action). Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) if there is insufficient time remaining, issue an Office

action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that the omission must be supplied within the remaining time period for reply. This notification should be made, if possible, by telephone, and, when such notification is made by telephone, an interview summary record (see MPEP § 713.04) must be completed and entered into the file of the application to provide a record of such notification. When notification by telephone is not possible, the applicant must be notified in an Office communication that the omission must be supplied within the remaining time period for reply. For example, when an amendment is filed shortly after an Office action has been mailed, and it is apparent that the amendment was not filed in reply to such Office action, the examiner need only notify the applicant (preferably by telephone) that a reply responsive to the Office action must be supplied within the remaining time period for reply to such Office action.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "*bona fide* attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment. Likewise, once

an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists. Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

37 CFR 1.135(c) authorizes, but does not require, an examiner to give the applicant a new time period to supply an omission. Thus, where the examiner concludes that the applicant is attempting to abuse the practice under 37 CFR 1.135(c) to obtain additional time for filing a reply (or where there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action), the examiner need only indicate by telephone or in an Office communication (as discussed above) that the reply must be completed within the period for reply to the non-final Office action or within any extension pursuant to 37 CFR 1.136(a) to avoid abandonment.

The practice under 37 CFR 1.135(c) of giving applicant a time period to supply an omission in a *bona fide* reply does not apply after a final Office action. Amendments after final are approved for entry only if they place the application in condition for allowance or in better form for appeal. Otherwise, they are not approved for entry. See MPEP § 714.12 and § 714.13. Thus, an amendment should be denied entry if some point necessary for a complete reply under 37 CFR 1.113 (after final) was omitted, even if the omission was through an apparent oversight or inadvertence. Where a submission after a final Office action or appeal (e.g., an amendment under 37 CFR 1.116) does not place the application in condition for allowance, the period for reply under 37 CFR 1.113 continues to run until a reply under 37 CFR 1.113 (i.e., a notice of appeal or an amendment that places the application in condition for allowance) is filed. The nature of the omission (e.g., whether the amendment raises new issues, or would place the application in condition for allowance but for it being unsigned or not in compliance with 37 CFR 1.121) is immaterial. The examiner cannot give the applicant a time period under 37 CFR 1.135(c) to supply the omission; however, applicant may obtain additional time under 37 CFR 1.136(a) to file another or supplemental amendment in order to supply the omission.

When a reply to a final Office action substantially places the application in condition for allowance, an examiner may request that the applicant (or representative) authorize an examiner's amendment to correct the omission and place the application in condition for allowance, in which case the date of the reply is the date of such authorization (and not the date the incomplete reply was filed). An examiner also has the authority to enter the reply, withdraw the finality of the last Office action, and issue a new Office action, which may be a non-final Office action, a final Office action (if appropriate), or an action closing prosecution on the merits in an otherwise allowable application under *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11, 435 O.G. 213 (Comm'r Pat. 1935) (if appropriate). These courses of action, however, are solely within the discretion of the examiner. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113.

Where there is an informality as to the fee in connection with an amendment to a **non-final** Office action presenting additional claims, the applicant is notified by the technical support staff on form PTOL-319. See MPEP § 607 and § 714.10.

Form paragraph 7.95, and optionally form paragraph 7.95.01, should be used where a *bona fide* reply is not fully responsive.

#### ¶ 7.95 *Bona Fide, Non-Responsive Amendments*

The reply filed on [1] is not fully responsive to the prior Office action because of the following omission(s) or matter(s): [2]. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

#### **Examiner Note:**

This practice does not apply where there has been a deliberate omission of some necessary part of a complete reply, or where the application is subject to a final Office action. Under such cases, the examiner has no authority to grant an extension if the period for reply has expired. See form paragraph 7.91.

#### ¶ 7.95.01 *Lack of Arguments in Response*

Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

#### **Examiner Note:**

1. This form paragraph must be preceded by form paragraph 7.95.
2. This form paragraph is intended primarily for use in *pro se* applications.

### **714.03(a) Amendment Unduly Interferes with the Preparation of an Office Action**

#### **I. PRELIMINARY AMENDMENT**

##### *37 CFR 1.115. Preliminary amendments.*

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104.

(b)(1) A preliminary amendment will be entered unless disapproved by the Commissioner. A preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of a first Office action in an application. Factors that will be considered in disapproving a preliminary amendment include:

(i) The state of preparation of a first Office action as of the date of receipt (§ 1.6) of the preliminary amendment by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the preliminary amendment.

(2) A preliminary amendment will not be disapproved if it is filed no later than:

(i) Three months from the filing date of an application under § 1.53(b);

(ii) The filing date of a continued prosecution application under § 1.53(d); or

(iii) Three months from the date the national stage is entered as set forth in § 1.491 in an international application.

(c) The time periods specified in paragraph (b)(2) of this section are not extendable.

Once the examiner has started to prepare a first Office action, entry of a preliminary amendment may be disapproved if the preliminary amendment unduly interferes with the preparation of the first Office action. Applicants are encouraged to file all preliminary amendments with the application or as soon as possible thereafter. Entry of a preliminary amendment will not be disapproved if it is filed no later than:

(A) 3 months from the filing date of the application under 37 CFR 1.53(b);

(B) 3 months from the date the national stage is entered as set forth in 37 CFR 1.491 in an international application;

(C) the filing date of a CPA under 37 CFR 1.53(d); or